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LAI, MICHAEL C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,429

Applicant(s)

DANIELL, W. TODD

Examiner

MICHAEL C. LAI

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to amendment filed on 1/26/2009.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/26/2009 has been entered.

Response to Amendment

The examiner has acknowledged the amended claims 13-19 and new claim 20. The objections to claims 18 and 19 have been corrected and withdrawn accordingly.

Response to Arguments

Applicant's arguments, see pages 7-12, filed 1/26/2009, with respect to the rejection(s) of claim(s) 1-20 under *35 USC § 103(a)* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Heyen et al.

Applicant's arguments, see page 7, with respect to "claims 13-19, as amended, fulfill all the requirements of *35 USC § 101*", is not persuasive. Claims 13-19 recite the limitation of "tangible computer readable medium..." that is described in page 34, second paragraph of the original specification as "a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the

program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium." As such, the claims would fairly suggest to one of ordinary skill signals or other forms of propagation and transmission media to be an appropriate manufacture under 35 USC 101 in the context of computer-related inventions. The newly added term "tangible" does not exclude signals or other forms of propagation and transmission media. The examiner suggests separating computer-readable storage medium from computer-readable propagation/transmission medium in the specification, and using "computer-readable storage medium" in the claims.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 13-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13-19 recite the limitation of "tangible computer readable medium..." that is described in page 34, second paragraph of the original specification as "a "computer-readable medium" can be any means that can contain, store, communicate, propagate, or transport the program for use by or in connection with the instruction execution system, apparatus, or device. The computer-readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium." As such, the

claims would fairly suggest to one of ordinary skill signals or other forms of propagation and transmission media to be an appropriate manufacture under 35 USC 101 in the context of computer-related inventions.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey et al. (US 2002/0087646 A1, hereinafter Hickey), in view of Heyen et al. (US 5,093,918, hereinafter Heyen).

Regarding claim 1, Hickey teaches a communication system comprising:

a client-side group email folder accessible by each user in a predefined group of users (FIG. 3 and para. 0037); and

a group email message in the client-side group email folder, the group email message having an indicator configured to indicate whether the corresponding group members have acted upon the group email message, wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses substantially all the limitations including the idea that users will each typically have an individual mailbox as well as access to group electronic

mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). However, Hickey fails to disclose specifically that each user in the predefined group has an indicator (instead of one indicator for the group), and the option to view at least one user-specific email, the user-specific email being different than the group email message. Heyen discloses a method for providing a user dependent status indication for shared electronic mail objects within a distributed computing system. Heyen further discloses an attribute list that is associated with each electronic mail object which may contain multiple sets of attributes, each set associated with a group of recipients, a subgroup of recipients or an individual end user having access to that electronic mail object. Thereafter, the activities of each end user are utilized to modify each attribute list associated with that end user. An end user may then periodically determine and display the status of an individual mail object with regard to the entire group of recipients, a subgroup of recipients or an individual end user (see abstract and column 2 line 61 through column 3 line 58). It would be obvious to one skilled in the art at the time of the invention was made to incorporate Heyen's teaching into Hickey's method for the purpose of supporting a user's group and private email status indications by defining three different view profiles (public, group, and private), thereby providing user-specific email being different than the group email message and a user dependent status indication suitable for utilization with shared electronic mail objects (i.e., group email folder) (see column 1, lines 41-44).

Regarding claim 2, Hickey teaches the system of claim 1, wherein each indicator comprises a first setting, the first setting indicating that the group email message has not been acted upon by the corresponding user (para. 0079, New).

Regarding claim 3, Hickey teaches the system of claim 2, wherein each indicator further comprises a second setting, the second setting indicating that the group email message has been acted upon by the corresponding user (para. 0043, acted upon information.).

Regarding claim 4, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has selected the group email message (para. 0063, first column 143A).

Regarding claim 5, Hickey teaches the system of claim 1, wherein each indicator is further indicative of whether the corresponding user has opened the group email message (para. 0079, Read, Answered, Moved, etc.).

Regarding claim 6, Hickey teaches the system of claim 1, further comprising a second indicator indicative of whether the corresponding user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 7, Hickey teaches the system of claim 1, further comprising means for indicating whether a user has deleted the group email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Regarding claim 9, Hickey teaches the system of claim 1, wherein each user represents a unique individual (para. 0051, lines 6-9).

Regarding claim 10, Hickey teaches a communication method comprising:

providing indicators in a group email message, the group email message being located in an inbox, each indicator corresponding to one of the users in a predefined group of users, each indicator having a setting, each indicator configured to indicate whether the corresponding user has acted upon the group email message (para. 0060, step 138 and para. 0061, step 140); and

changing the setting of one indicator in response to the email message being acted upon by its corresponding user (para. 0064), wherein the group email message is stored in a common database such that users of the group have access to the group email message via the database (FIG. 3 and para. 0010, 0021, 0043, 0057).

Hickey discloses the claimed invention except for the option to view at least one user-specific email, the user-specific email being different than the group email message. However, Hickey also teaches that users will each typically have an individual mailbox as well as access to group electronic mailbox. Users can electronically communicate with one another by exchanging e-mail messages over the network through individual e-mail mailboxes and group electronic mailbox 25 (see FIG. 2 and para. 0036). It would therefore be obvious to one of ordinary skill in the art at the time of the invention was made to combine Hickey's teachings for the purpose of avoiding the hassle of jumping between group email messages and user-

specific email messages by providing an email interface for providing the group email message and an option to view at least one user-specific email, the user-specific email being different than the group email message, thereby providing a more user-friendly and more productive environment.

Regarding claim 11, Hickey teaches the method of claim 10, wherein providing indicators comprises providing read indicators, each read indicator corresponding to one user in a predefined group of users, each read indicator being configured to indicate whether its corresponding user has read the email message (para. 0079, Read).

Regarding claim 12, Hickey teaches the method of claim 10, wherein providing indicators comprises providing delete indicators, each delete indicator corresponding to one user in a predefined group of users, each delete indicator being configured to indicate whether its corresponding user has deleted the email message. each delete indicator being configured to indicate whether its corresponding user has deleted the email message (para. 0078, lines 12-20 and para. 0079, lines 1-3).

Claim 13 is of the same scope as claim 10. It is rejected for the same reason as for claim 10.

Claim 14 is of the same scope as claim 11. It is rejected for the same reason as for claim 11.

Claim 15 is of the same scope as claim 12. It is rejected for the same reason as for claim 12.

Claim 16 is of the same scope as claim 4. It is rejected for the same reason as for claim 4.

Claim 17 is of the same scope as claim 5. It is rejected for the same reason as for claim 5.

Claim 18 is of the same scope as claim 7. It is rejected for the same reason as for claim 7.

Claim 20 is of the same scope as claim 12. It is rejected for the same reason as for claim 12.

5. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey, in view of Stark et al. (US 2003/0233420 A1, hereinafter Stark).

Regarding claim 8, Hickey teaches the system of claim 1, but fails to disclose wherein the indicator is an extensible markup language (XML) tag corresponding to a user in the predefined group. However, Stark shows embedded XML tags that describe certain attributes of messages [Page 3, Para. 0035]. It would therefore be obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Stark into Hickey's system to use XML tag for the indicator corresponding to a user in the predefined group. The motivation would be taking the advantage of the widely accepted language of e-commerce (XML).

Claim 19 is of the same scope as claim 8. It is rejected for the same reason as for claim 8.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure

relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Lai whose telephone number is (571) 270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
9FEB2009

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Supervisory Patent Examiner, Art Unit 2457